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No. 95-2033

IN THE
Supreme Court of the United States
OCTOBER TERM, 1996

BP CHEMICALS LIMITED and
STERLING CHEMICALS, INC.,
Petitioners,

v.

HOECHST CELANESE CORPORATION,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

SUPPLEMENTAL BRIEF OF PETITIONERS

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September 18, 1996

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SUPPLEMENTAL BRIEF OF PETITIONERS

Pursuant to Rule 15.8 of the Rules of this Court, petitioners respectfully submit this supplemental brief to bring to the Court's attention a new decision of the United States Court of Appeals for the Federal Circuit, *Vitronics Corp.* v. *Conceptronic, Inc.*, 90 F.3d 1576 (July 25, 1996), that was issued after all briefing with respect to the petition for certiorari had been completed.

In *Vitronics*, a panel of the Federal Circuit reversed a trial court judgment of non-infringement of a patent on the ground that the trial court had improperly relied on expert testimony and other extrinsic evidence in interpreing a disputed term in the patent claims. The court held that such reliance was improper because the patent documents, including the language of the claims themselves and the patent specification, were clear and unambiguous as to the meaning of the disputed term. Because the docu-

ments themselves provided a clear answer, the court held that consideration of extrinsic evidence was unnecessary and, indeed, inappropriate.

The court explained that in interpreting a patent claim, courts "should look first to the intrinsic evidence of record, *i.e.*, the patent itself, including the claims, the specification and, if in evidence, the prosecution history." *Id.* at 1582. Only if this evidence is ambiguous may courts rely on extrinsic evidence, *i.e.*, "evidence which is external to the patent and file history, such as expert testimony, inventor testimony, dictionaries, and technical treatises and articles." *Id.* at 1584. The patent documents and prosecution history should be examined first because they "constitute the public record of the patentee's claim, a record on which the public is entitled to rely" in designing around the claimed invention. *Id.* at 1583. If the public record of the patentee's claim is unambiguous, reliance on extrinsic evidence is " 'unfair to competitors who must be able to rely on the patent documents themselves, without consideration of expert opinion that then does not even exist, in ascertaining the scope of a patentee's right to exclude.' " *Id.* at 1584 (quoting *Southwall Tech., Inc.* v. *Cardinal IG Co.*, 54 F.3d 1570, 1578 (Fed. Cir. 1995)). Finally, the court noted that "the inventor's subjective intent as to claim scope, when unexpressed in the patent documents, [should not] have any effect." *Id.* at 1584.

The petition in this case presents the question whether a court interpreting a patent claim may rely on extrinsic evidence, such as self-serving inventors' testimony, that was not available to members of the public attempting in good faith to construe the patent. The petition argues that this Court should address that issue because different panels of the Federal Circuit, which has exclusive appellate jurisdiction over all patent infringement cases nationwide, have taken different approaches to that issue and have reached inconsistent results.

The decision in the *Vitronics* case demonstrates the continuing lack of uniformity within the Federal Circuit

concerning the treatment of extrinsic evidence such as inventor testimony. The panel that decided *Vitronics* recognized that reliance on the inventor's subjective testimony in an infringement suit is fundamentally unfair because that information was not part of the public patent file available to competitors who sought to design around the patent. By contrast, the panel of the Federal Circuit that decided petitioners' appeal gave dispositive weight to the self-serving testimony of the inventor in construing respondent's patent, even though that information was unavailable to petitioners when they attempted to construe the patent in good faith based on the public documents. As a result, petitioners' panel construed the disputed patent term in respondent's favor and required petitioners to pay substantial royalties. Such disparate results within the Federal Circuit are intolerable and, as *Vitronics* illustrates, will recur until this Court grants review and finally decides what relevance an inventor's subjective intent has in the claim interpretation process.

For the foregoing reasons, and for the reasons set forth in the petition and reply, the petition for a writ of certiorari should be granted, or alternatively, should be held pending this Court's disposition of the *Hilton Davis* case.

Respectfully submitted,

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